REMARKS

This responds to the Office Action mailed on September 20, 2008.

Claims 1, 4, 6-7, 10-11, 13-15, 17, 20-21, 24, 27-28, 30, 32, 35-36, 38, 41-42, 44, 47 and 50-51 are amended, no claims are canceled in this response, claims 9, 19, 26, 34, 40 and 49 were previously canceled, and claims 53-58 are added; as a result, claims 1-8, 10-18, 20-25, 27-33, 35-39, 41-48 and 50-58 are now pending in this application.

Double Patenting Rejection

Claims 1-8, 10-18, 20-25, 27-33, 35-39, 41-48 and 50 were rejected under a non-statutory double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 6,517,433 to Loose (Loose) of record in view of U.S. Patent No. 6,375,570 to Poole (Poole) of record and U.S. Patent 6,270,411 to Gura et al. (Gura) of record.

Applicant does not admit that the currently pending claims are obvious in view of U.S. Patent No. 6,517,433 to Loose (Loose) of record in view of Loose, Poole and Gura. However, Applicant will consider filing a Terminal Disclaimer in compliance with 37 C.F.R. 1.321(b)(iv) when all other issues related to the patentability of the claims have been resolved.

§103 Rejection of the Claims

Claims 1-8, 10-13, 17-18, 20-25, 27-33, 35-39, 41-48 and 50-52 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,517,433 to Loose of record in view of U.S. Patent 6,270,411 to Gura of record.

Claims 1-8, 10-13, 17-18, 20-25, 27-33, 35-39, 41-48 and 50-52 were also rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,375,570 to Poole of record in view of U.S. Patent 6,270,411 to Gura of record.

The determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence. *See Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1336-37 (Fed.Cir. 2005). The legal conclusion that a claim is obvious within § 103(a) depends on at least four underlying factual issues set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966). The underlying factual issues set forth in

Graham are as follows: (1) the scope and content of the prior art; (2) differences between the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) evaluation of any relevant secondary considerations.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir.1988). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested, by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) ; M.P.E.P. § 2143.03. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) ; M.P.E.P. § 2143.03. As part of establishing a *prima facie* case of obviousness, the Examiner's analysis must show that some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.* To facilitate review, this analysis should be made explicit. *KSR Int'l v. Teleflex Inc., et al.*, 127 S.Ct. 1727; 167 L.Ed 2d 705; 82 USPQ2d 1385 (2007) (citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)).

The test for obviousness under §103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements that define the invention. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir.1985). The Examiner must, as one of the inquiries pertinent to any obviousness inquiry under 35 U.S.C. §103, recognize and consider not only the similarities but also the critical differences between the claimed invention and the prior art. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971, (Fed. Cir.1990). Moreover, "mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole." *In re Kahn,* 441 F. 3d 977, 988 (Fed. Cir. 2006). This was recently echoed by the U.S. Supreme Court in *KSR Int'l v. Teleflex Inc., et al.*, 127 S.Ct. 1727; 167 L.Ed 2d 705; 82 USPQ2d 1385 (2007) (a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.).

Independent claims 1, 4, 7, 17, 24, 32, 38, 44 and 47 have been amended to clarify that the game elements are video images that are overlaid by other video images. Thus the

overlaying and overlaid images comprise video data. Further, each of the independent claims have been amended to clarify that each image that is overlaid remains at least partially visible after the overlaying of the video data. For example, claim 1 as amended recites "overlaying in a memory storing video data pixel values of the at least one symbol element with pixel values of the supplemental graphical element, wherein each of the at least one symbol element that is overlaid remains at least partially visible while the supplemental graphical element is displayed." Each of the independent claims has been amended to recite language similar to the amendment shown above for claim 1. Applicant respectfully submits that no combination of Loose, Poole or Gura discloses overlaying video data with other video data such that the overlaid symbol or gaming element remains at least partially visible. In Loose, the game symbols or elements are not video data. Rather the game symbols comprise mechanical reels (see e.g., Abstract). Thus there is no overlaying in a video memory of game elements or symbols with video data such that the overlaid symbols remain partially visible.

In Gura, there are game elements that do not remain partially visible. For example, the video illustrated in Figs. 10 and 11 shows that the center symbol of the center reel is totally covered by the video display, and therefore does not remain partially visible. Gura does not teach or suggest that each symbol that is overlaid remains at least partially visible.

Similarly, in Poole, the video data completely covers one or more symbols. For example, Poole's Fig. 5 illustrates that the center video reels are completely covered such that no overlaid game element remains partially visible. Poole does not teach or suggest that game elements or symbols are overlaid such that each overlaid element or symbol remains at least partially visible.

Thus in view of the above, none of Loose, Poole or Gura, alone or in combination, discloses overlaying game element or symbol video data with supplemental video data such that each game element or symbol that is overlaid remains at least partially visible. Therefore no combination of Loose, Poole or Gura discloses each and every element of claims 1, 4, 7, 17, 24, 32, 38, 44 and 47. As a result, claims 1, 4, 7, 17, 24, 32, 38, 44 and 47 are nonobvious because there are differences between the cited references and Applicant's claims. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 1, 4, 7, 17, 24, 32, 38, 44 and 47.

Each of dependent claims 2-3, 5-6, 8, 10-16, 18, 20-23, 25, 27-31, 33, 35-37, 39, 41-43, 45-46, 48 and 50-52 depends from an independent claim and is therefore allowable for at least the reasons discussed above regarding their respective independent base claims. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is also nonobvious. MPEP § 2143.03.

New Claims 53-58

Claims 53-58 have been added in this response. Support for claims 53-58 may be found throughout the specification and at least on pages 10 and 13 of the specification. Applicant believes that no new matter has been introduced in new claims 53-58.

Claims 53-58 depend from claims 1, 4, 7, 24, 38 and 47 respectively. Claims 53-58 are therefore allowable for at least the reasons discussed above regarding their respective base claims. Additionally, each of claims 53-58 recites that the boundary of a supplemental graphical element or set of video images that provide the overlay is determined by a component of the image itself. For example, a video image containing a character that is to be used as an overlay may have an overlay boundary determined by the boundary of the character. Applicant has reviewed Loose, Poole and Gura, and can find no teaching or suggestion of using a boundary of a component within an image to determine the boundary of an overlay image. As a result, new claims 53-58 recite elements that are not found in any combination of Loose, Poole and Gura and are therefore allowable.

Further, claim 56 recites that the boundary of image overlaying a game element may change from image to image in a set of video image, where the boundary change corresponds to a change in the boundary of a component within the set of video images. For example, if a character moves in the set of video images, then the boundary of the overlaying images changes as the character moves. None of Loose, Poole or Gura teaches or suggests that the boundary of an overlaying image may change in the manner recited in claim 56.

Reservation of Rights

In the interest of clarity and brevity, Applicant may not have equally addressed every assertion made in the Office Action, however, this does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 373-6954 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 373-6954

Date March 20, 2008

By _____
Rodney L. Lacy
Reg. No. 41,136

CERTIFICATE UNDER 37 CFR § 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 20 day of March 2008.

Rodney L. Lacy
Name

Signature